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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,289	07/24/2001	Jeffrey J. Norman	0102	5203

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H. GORDON SHIELDS  
7830 NORTH 23RD AVENUE  
PHOENIX, AZ 85021

EXAMINER

SINGH, SUNIL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/912,289

Applicant(s)

NORMAN ET AL.

Examiner

Sunil Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 27-30 is/are allowed.
- 6) ☒ Claim(s) 1, 4, 13, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 5-12, 14, 15 and 18-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Applicant's appeal brief filed 2/19/04 is confusing since claim 17 is Grouped to stand/fall together with claim 1 and then it is Grouped to stand/fall alone.

The examiner has withdrawn the finality of office action mailed 12/16/03; the following rejections now apply.

The examiner is not clear if applicant is invoking 112 6<sup>th</sup> paragraphs in his "means plus function language" since the means plus function language seems to not meet the 3-prong test. See MPEP 2181.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 1, 13, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitfield, Jr. (US 6419421).

Whitfield, Jr. discloses an underground retention apparatus ((11), see Fig. 7) comprising in combination perimeter support means (2) for providing structural support; liner means (3) secured to the perimeter support means for holding a quantity of run off water; means (13) for draining run off water onto the liner; means for draining the run off water from the liner (14); and roof means (5) disposed on the perimeter support means for covering the liner and for providing structural support for appropriate usage of the roof means.

(Re claim 13), the liner means includes an upper side wall portion (this is considered as a top portion of side plate (3)), a lower side wall portion (this is considered as a middle portion of side plate (3)), and a bottom portion (this is considered as the bottom portion of side plate (3)).

(Re claim 16), the liner is made of plastic (see abstract).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield Jr..

Whitfield, Jr. discloses the invention substantially as claimed. However, Whitfield, Jr. is

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silent about the liner being made out of cementitious material. The examiner takes official notice that it is well known to make liner/reservoir out of cementitious material. It would have been considered obvious to one ordinary skill in the art to modify Whitfield, Jr. by making his liner out of cement since such material is known to be used to make liners in order to have liner/reservoir that would withstand great lateral forces.

Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield Jr. in view of Zimmerman (US 4298294).

Whitfield Jr. discloses the invention substantially as claimed. However, Whitfield Jr. lacks having a pump to drain the water from the liner. Zimmerman teaches having a pump to drain water (see Fig. 2). It would have been considered obvious to one of ordinary skill in the art to modify Whitfield Jr. to include a pump as taught by Zimmerman in order to facilitate the transport of the water to a desired location.

### ***Response to Arguments***

6. Applicant's arguments filed 2/19/04 have been fully considered but they are not persuasive. Applicant argues that the side plates (3) of Whitfield, Jr. are part of the support means. Applicant admits that member (2) is also part of the support means. There is nothing in the claims precluding the examiner's interpretation that member (2) is the supporting means and member (3) is the liner means since the claims do not prevent the liner means for providing some perimeter support in conjunction with

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member (2). Applicant argues that member (3) cannot be considered as the liner means. The examiner is unclear why applicant's interpretation is considered to be the only valid one. The examiner fails to see what in the claims precludes member (3) from being considered the liner means. Applicant argues that the opening in member (5) is what is considered as the "means for draining run off water onto the liner". This is not true. Applicant is misrepresenting the examiner's position. Please note above that the "means for draining run off water onto the liner" is considered as member (13) and not the openings in member (5). Applicant's argument that the "roof means" of his apparatus provides structural support for appropriate usage such as a parking lot is far more limiting than the claimed subject matter. Applicant argues the member (5) is not a roof means but instead a means for draining run off water onto the liner means. Once again there is nothing in the claims precluding examiner's interpretation that member (5) is the roof means and member (13) is the means for draining run off water onto the liner means.

***Allowable Subject Matter***

7. Claims 2,3,5,6,7,8,9,10,11,12,14,15,18,19,20,21,22,23,24,25,26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 27-30 are allowed.

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**Conclusion**


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday 8:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh

  
Patent Examiner  
Art Unit 3673

SS  
  
5/14/2004